UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,850	02/14/2001	Steven Mark Gebert	8185P010	9299

76073 7590 04/26/2012

InfoPrint Solutions/ Blakely
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

EXAMINER	
QUELER, ADAM M	
ART UNIT	PAPER NUMBER
2177	

MAIL DATE	DELIVERY MODE
04/26/2012	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN MARK GEBERT, DAVID GEORGE GREENWOOD, REINHARD HEINRICH HOHENSEE, HARRY REESE JR. LEWIS, DWIGHT ROSS PALMER, ARTHUR RAY ROBERTS, and DAVID EARL STONE

Appeal 2010-001960
Application 09/782,850
Technology Center 2100

Before: ALLEN R. MACDONALD, ST. JOHN COURTENAY III, and CAROLYN D. THOMAS, *Administrative Patent Judges*.

PER CURIAM

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a rejection of claims 49-87. Claims 1-48 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We Affirm.

Invention

The disclosed invention relates generally to a method, system, and program for preprocessing a document for rendering on an output device. (Spec. 1). In accordance with one embodiment, a source document is received along with a page layout data structure that provides formatting properties specifying a layout and format of the content output. The source document and the page layout data structure are processed to determine page divisions and formatting properties for the content in the source document. Multiple page objects are generated, wherein each page object includes content and formatting properties for at least one page. A rasterizer transforms the page objects into renderable information for printing. (Spec. 4).

Independent claim 49, reproduced below, is illustrative of the claimed subject matter:

> 49. A method for processing a source document in a structured document format including elements providing source content to render, wherein the source content comprises code that is rasterized into output, comprising:
>
> receiving the source document including source content in a presentation language; receiving a layout data structure separate from the source document, providing formatting properties specifying a layout and format of the content output,

wherein the layout data structure does not include source content;

processing the source document and the layout data structure to determine formatting properties, including page divisions, for the content in the source document;

generating *a first page object* including the source content in the presentation language used in the source document and formatting properties *for only a first page*; generating *a second page object* including the source content in the presentation language used in the source document and formatting properties *for only a second page*, wherein the first page object includes a first set of content elements to place on the first page and the second page object includes a second set of content elements to place on the second page; and

transmitting the first page object and second page object to a rasterizer to transform into renderable information capable of being generated by an output device.

(emphasis added).

REJECTIONS

Claims 49-87 stand rejected under *Res Judicata* based on a prior adjudication against the inventor on patentably non-distinct claims involving the same issues.

Claims 49-56, 60-69, 73-81 and 85-87 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adler et al., "Extensible Stylesheet Language (XSL)" Version 1.0, pub. Oct. 18th, 2000, ("Adler") and Saito (US Pat. 5,323,312).

Claims 57, 59, 70, 72, 82, and 84 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adler, Saito, and Barry (US Pat. 6,606,165 B1).

Claims 58, 71, and 83 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Adler, Saito, Barry, and Sall (as found in the IDS - FOP: Formatting Object to PDF Translator (James Tauber), pub. 1999).

PRIOR DECISION

Appeal No. 2007-2804 (Application No. 09/782,850), mailed January 23, 2009. (Affirmed).

GROUPING OF CLAIMS

Based on Appellants' arguments in the Brief, we decide the appeal on the basis of representative claim 49. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' contentions that the Examiner has erred. Further, we have reviewed the Examiner's response to each of the independent claims argued. (Claims 49, 62, and 75). We disagree with Appellants' conclusions. We adopt as our own: (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken, and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal Brief. (Ans. 13-15). On this record, we concur with the underlying factual findings and ultimate legal conclusion of obviousness reached by the Examiner.

Appellants principally contend that neither Adler nor Saito disclose or suggest a first page object including formatting properties for only a first page and a second page object including formatting properties for only a second page. (App. Br. 14, ¶3).

However, we agree with the Examiner's claim interpretation that merely clarifying that *each* page object contains the content and formatting for only one page object does not distinguish the current claims from the previously adjudicated claims. (Ans. 13-14). Thus, we agree with the Examiner that the doctrine of *res judicata* is applicable in this appeal. See, e.g., the following portion of the Examiner's claim chart in the Answer 5-6:

Prior Decision (Claim 1):	Claim 49 on appeal:
generating ***multiple page objects*** wherein ***each page object*** includes the source content in the presentation language used in the source document and the determined formatting properties ***for one page***	Generating ***a first page object*** including the source content in the presentation language used in the source document and formatting properties ***for only a first page***; generating ***a second page object*** including the source content in the presentation language used in the source document and formatting properties for ***only a second page***,

Moreover, even if we assume *arguendo* that the doctrine of *Res Judicata* does not apply in this appeal (as contended by Appellants), we find unavailing Appellants' attempt to distinguish the present independent claims over the cited prior art in terms of the number of elements. In particular, we conclude that such arrangement is merely the use of prior art elements

according to their established functions to realize a predictable result. As such, we conclude, that claiming "a first page object" and "a second page object" instead of *multiple page objects* and replacing the previous claim language of "for one page" (claim 1, Prior Decision) with "for only a first page" and "for only a second page object" is not a patentable distinction over the prior art of record. (Representative claim 49).

"When a patent 'simply arranges old elements with each performing the same function it had been known to perform' and *yields no more than one would expect from such an arrangement*, the combination is obvious." *KSR Int'l Co. v. Teleflex, Inc.*, 550 US 398, 417 (2007) (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282 (1976)) (emphasis added). Moreover, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR* at 418.

This reasoning is applicable here. We also observe that Appellants have not provided any factual evidence of secondary considerations, such as *unexpected* or *unpredictable* results, commercial success, or long felt but unmet need. Nor have Appellants filed a Reply Brief rebutting the Examiner's response to Appellants' contentions in the Appeal Brief. (*See* Ans. 13-16).

As pointed out by the Examiner (Ans. 3), Appellants have not presented separate arguments for the third and fourth-stated grounds of rejection, covering the §103 rejections of dependent claims 57, 59, 70, 72, 82, and 84, and dependent claims 58, 71, and 83, respectfully. Instead, Appellants urge that these claims are patentable over the prior art for the

same reasons discussed above regarding independent claims 49, 62, and 75. (App. Br. 15).

Therefore, on this record, we are not persuaded by Appellants' arguments that the Examiner erred regarding any of the rejections on appeal.

DECISION

We affirm the Examiner's rejection of claims 49-87 under the doctrine of *Res Judicata* based on a prior adjudication against the inventor on patentably non-distinct claims involving the same issues.

We affirm the Examiner's §103 rejections of claims 49-87.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 41.50(f).

AFFIRMED

tkl